

REMARKS

Claims 1-166 are currently pending in this application. By this Amendment, Applicant has amended claims 1, 7, 10, 57, 62, 65, 111, 117, and 120. More specifically, Applicant has placed claims 7, 10, 62, 65, 117, and 120 in independent form, and has amended original independent claim 1, 57, and 111 by adding the recitation "wherein the application element is configured to apply product to at least one of skin, hair, toenails, and fingernails and/or wherein the reservoir contains a product chosen from at least one of a skin product, a hair product, a toenail product and/or a fingernail product." Support for the claim amendments can be found at least, for example, in the original claims and in the specification at page 1, paragraph [001], page 9, paragraph [035], and page 17, paragraph [079]. No new matter has been introduced.

To the extent the claim rejections set forth in the Office Action dated September 25, 2003, may apply to the currently pending claims, those rejections should be withdrawn and the pending claims should be allowed for the reasons explained below.

In the Office Action, claims 1, 2, 6, 7, 10-15, 19, 24, 25, 29, 40-43, 45-57, 61, 62, 64-70, 74, 79-81, 84-86, 94-97, 99-112, 116, 117, 119-125, 129, 134-136, 139-141, 149-153, and 155-166 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,348,031 to Cloud.

Cloud discloses a cosmetic apparatus including a compact 12 having a pair of clamshell members 16, 17 which bend toward and away from each other. Cloud further discloses an applicator 14 that bends toward the clamshell compact member

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

17. The clamshell compact member 16 defines two recesses 21, 22, and the clamshell compact member 17 defines two recesses 23, 24. Cloud explicitly discloses that the cosmetic applicator 14 includes a stem portion 30 having a quantity of cosmetic 32 affixed to its outer end. Cloud further discloses the cosmetic applicator having an enlarged portion 33 provided with a pair of outwardly extending spacer members 34-34 which engage the surface of recess 24 when the applicator 14 resides parallel to the compact member 17. In this parallel position, Cloud further discloses that cosmetic 32 resides within the recess 23 but spaced from the surface of the recess 23 so as "to prevent smearing or damage to the cosmetic."

Thus, Cloud explicitly teaches that the cosmetic in Cloud's disclosed cosmetic apparatus is at the end of the stem portion 30 rather than contained in the recess 24. Since Cloud contains no explicit disclosure regarding the recess 24 being configured to contain a product, as asserted by the Examiner at page 2 of the Office Action, it appears the Examiner is relying on principles of inherency to support that assertion. However, to establish inherency, the Examiner must show that "the missing descriptive matter is *necessarily* present" in the reference. See M.P.E.P. §2112 (*quoting In re Robertson*, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. §2112 (emphasis in original.) In this case, the Examiner has failed to establish such inherent disclosure since the recess 24 is not *necessarily* configured to contain a cosmetic product. In particular, Cloud explicitly teaches that the

spacers 34-34 on stem portion 30 engage the surface of the recess 24 in order to properly position the applicator 14 within the compact member 17. If recess 24 were configured to contain a product, as the Examiner asserts, the spacers 34-34 would be prevented from engaging with the surface of the recess 24. This would destroy the explicit function of the spacers 34-34 and recess 24 taught by Cloud. Therefore, Cloud neither explicitly nor inherently discloses recess 24 being "configured to contain a product," For at least this reason, independent claims 1, 7, 10, 57, 62, 65, 111, 117, and 120, each of which recites "a reservoir configured to contain a product," as well as their respective dependent claims, are patentably distinguishable from Cloud, and the Section 102 rejection based on Cloud should be withdrawn.

Also in the Office Action, claims 1-4, 6-11, 13-33, 35-43, 45-59, 61-66, 68-88, 90-97, 99-114, 116-121, 123-143, 145-153, and 155-166 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,382,107 to Nian, and claims 1-9, 11-16, 19-21, 24-30, 32-64, 66, 68-71, 74-76, 79-119, 121, 123-127, 129-131, and 134-166 were rejected under either 35 U.S.C. § 102(b) or § 103(a) based on U.S. Patent No. 3,741,667 to Cesari, either taken alone or in combination with U.S. Patent No. 4,056,110 to Landsman.

Cesari discloses a toothbrush having a bristle portion 2 combined with a container 1 which holds and dispenses toothpaste onto the bristles of the toothbrush. Nian discloses a foldable tooth brush 1 including a handgrip portion 2, an elongated head portion 3 with a bristle unit 32 mounted thereon, and a connector 4 interconnecting the handgrip portion 2 and the head portion 3. Neither Cesari nor

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Nian, however, discloses a device “wherein the application element is configured to apply product to at least one of skin, hair, toenails, and fingernails and/or wherein the reservoir contains a product chosen from at least one of a skin product, a hair product, a toenail product and/or a fingernail product,” as recited in claims 1, 57, and 111, “wherein the application element is made of a compressible material,” as recited in claims 7, 62, and 117, or “wherein the application element is made of a sintered material,” as recited in claims 10, 65, and 120. Indeed, the Examiner points to no disclosure in either Nian or Cesari which teaches or otherwise suggests any of the above-quoted limitations. Further, Landsman also relates to a combination toothbrush and paste dispenser and does not cure the above-noted deficiencies of either Nian or Cesari, and the Examiner does not rely on Landsman for such teachings.

For at least these reasons, claims 1, 7, 10, 57, 62, 65, 111, 117, and 120, and their respective dependent claims, are patentably distinguishable from Nian and from Cesari, whether taken alone or in combination with Landsman, and the various claim rejections based on these references should be withdrawn.

Claims 2-6, 8, 9, 11-56, 58-61, 63, 64, 66-110, 112-116, 118, 119, and 121-166 depend either directly or ultimately from claims 1, 57, and 111, respectively, and therefore are patentable for at least the same reasons each of claims 1, 57, and 111 is allowable. In addition, at least some of these dependent claims recite unique features and combinations which are neither taught nor suggested by the cited art and therefore at least some also are separately patentable.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Applicant respectfully requests the withdrawal of the outstanding rejections and the timely allowance of claims 1-166.

The Office Action contains various characterizations and assertions regarding Applicant's claims and the cited art with which Applicant does not necessarily agree. Regardless of whether Applicant has specifically addressed those characterizations and assertions, Applicant declines to subscribe to the same.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 23, 2004

By: *Susanne T. Jones*
Susanne T. Jones
Reg. No. 44,472

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com